

### Remarks

#### **Legal, Practical and Equitable Considerations Mandate Examination of Applicants' Claims in a Single Application**

A close examination of the legal, practical and equitable considerations surrounding this application compels withdrawal of the examiner's restriction requirement and requires a single search and examination of all the claims pending in the application.

In levying the restriction requirement, the examiner divided the claims pending in the application into three defined groups and one undefined group. The examiner asserted that Group I embraced claims 1-11 and 31-34 (which have now been cancelled) which the examiner characterized as being drawn to textured yarns, staple fibers, or single and/or multi-component yarns and which the examiner viewed as belonging in class 428, subclass 357+.

The examiner asserted Group II to embrace claims 12-21, 29, 30 and 48-51 which the examiner characterized as being drawn to non-woven fabric and which the examiner viewed as belonging in class 442, subclass 327+.

The examiner asserted Group III to embrace claims 22-28 (all of which have now been cancelled) and 52-54 which the examiner characterized as being drawn to filtration and coalescing media and which the examiner viewed as belonging in class 210, without any subclass being specified.

The examiner further asserted that claims 22-28 (which have since been cancelled) and claims 35-47 (claims 39 through 47 have also since been cancelled) encompass a plethora of compositions, products, processes and apparatus which allegedly placed those claims outside the scope intended by 35

U.S.C. 101. Hence the examiner did not make those claims subject to restriction. For purposes of this Response to Restriction Requirement, applicants have identified claims remaining 35-38 as Group IV.

The examiner asserts that the claims in these three (or four) groups are distinct, each group from the other.

Applicants respectfully note that in the restriction context the test for whether inventions, defined by groups of claims, are “distinct” is a multi-prong test: “Distinct means that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, **AND ARE PATENTABLE** (novel and unobvious) **OVER EACH OTHER**”. *MPEP 802.01*. (emphasis in the original)

In asserting distinctness among all of the groups of inventions, each group from the other, the examiner has stated that the inventions of Groups I vis-à-vis the inventions of Groups II & III taken together are related as mutually exclusive species in an intermediate-final product relationship.

Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3<sup>rd</sup> paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product of textured yarns, staple fibers, or single and/or multi-component yarns is deemed a useful component in fiber-reinforced structures, building materials and laminates.

The examiner has further asserted restriction between the inventions of Groups 1 and 2 taken together and the inventions of Group 3, as allegedly being related as mutually exclusive species in an intermediate-final product relationship:

The inventions of Groups (I & II) and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3<sup>rd</sup> paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate non-woven product comprising the textured yarns, staple fibers, or single and/or multi-component is useful component in textile laminates such as those used in disposable personal care articles or in medical applications.

Applicants respectfully submit that, **for purposes of restriction analysis only** and without prejudice to whatever position applicants may take on patentability in the course of prosecution of the claims on their merits, the claims in the three groups into which they have been segregated by the examiner may not be patentable over one another. Without prejudice to that position, applicants respectfully note that whether or not the claims of the respective groups are patentable over one another, it is the examiner's burden to show lack of patentability of the groups of claims vis-à-vis one another in order to satisfy the patentability prong of the distinctness test. The examiner has not done this.

Applicants respectfully note that the restriction requirement is **silent** respecting the patentability of any claim, in any one of the groups of claims, vis-à-vis any claim in any of the other groups. Applicants further respectfully note that the fact that the claims have been arbitrarily categorized into separate classes and subclasses by the examiner in levying the restriction requirement does not address the issue of the patentability of the groups of claims vis-à-vis one another; there is nothing addressing patentability prong of the distinctness test for purposes for restriction analysis.

Applicants note that there are many common characteristics and much common subject matter shared by the claims the examiner segregated into separate, purportedly “distinct”, groups. The inventions of Group 1 by the terms of the claims are directed to yarns and fibers, with the exception of claim 10 which is directed to “a knitted fabric”. The inventions of Group 2, according to the terms of the claims, are directed to fabric (claims 12, 14 and 15), a carded batt (claim 13), yarns and fibers (claims 20 and 21), a needlefelt (claims 29 and 30) derived from fibers defined by claim 11 (which significantly is a member of Group 1), and a scrim supported needlefelt (claims 48, 49, 50 and 51) made from a blend of the fibers defined by claim 11 (which applicants note again is a member of Group 1). While applicants readily concede that the textured yarns, staple fibers and single and/or multicomponent yarns of claims 1 through 9 and 11 of Group 1 may be useful to make products in addition to, and other than, the products that are the subject of the claims of Group 2, **for purposes of restriction analysis only**, applicants **do not** concede that the claims of Group 1

directed to the textured yarns, staple fibers and single and/or multicomponent yarns, namely claims 1 through 9 and 11, are patentably distinct from the claims of Group 2, namely claims 12 through 21, 29, 30 and 48 through 51. This is especially so when applicants note that of the sixteen claims constituting Group 2, only two of those claims (claims 20 and 21) are independent claims; the remaining claims of Group 2 all depend, directly or indirectly, from claim 11 which is a member of Group 1.<sup>1</sup> Hence, the overwhelming majority of the claims in Group 2 incorporate limitations of a claim from Group 1. In light of this, applicants respectfully seriously question the claim grouping for restriction purposes as set forth by the examiner in the official action and request, at the very least, reconsideration of the claim groupings.<sup>2</sup>

Further respecting the requirement for a showing of patentability as between the claims of Groups 1 and 2 and the lack of same in the restriction requirement, applicants respectfully submit, for purposes of restriction analysis only, that it is may be difficult, if not impossible for the examiner to assert unobvious patentability of the claims of Group 2 vis-à-vis the claims of Group 1.

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1 See paragraphs 9, 10, 13 and 15 of the attached Declaration of Frank Cistone.

2 Applicants note a degree of illogicity in the examiner's position on the restriction requirement. In one paragraph, the examiner positions the inventions of Group 1 against the inventions of Groups 2 and 3, as a combined unitary whole and states that these two groupings are related as mutually exclusive species in an intermediate-final product relationship. In the very next paragraph, the examiner positions the inventions of Groups 1 and 2 together, as a combined unitary whole, as against the inventions of Group 3 and contends that these two groupings are related as mutually exclusive species in an intermediate-final product relationship. This second grouping by the examiner implies that the inventions of Groups 1 and 2, as a combined unitary whole, are all directed to an intermediate as respects to the purportedly final product defined by the claims of Group 3. This being the case, applicants respectfully submit that it is illogical and inappropriate to separate these intermediate claims into two groups as the examiner has done in the first part of the restriction requirement, and then to assert in the second part of the restriction requirement that these two groups when combined are allegedly "mutually exclusive species". Reconsideration of the claim groupings is respectfully solicited together with withdrawal of the restriction requirement in all of its aspects.

In that regard, applicants respectfully note that Group 2 constitutes sixteen claims, only two of which are independent. The remaining fourteen claims of Group 2 all depend, directly or indirectly, from claims which are members of Group 1. Hence, nearly all of the claims in Group 2 involve structural or material limitations which have been imported from the claims of Group 1. **For purposes of restriction analysis only**, applicants respectfully submit that it would be a heavy, heavy burden for the examiner to demonstrate putative unobvious patentability of the claims of Group 2, given that those claims incorporate numerous material and structural limitations from the claims of Group 1. In light of the clear requirement for a showing by the examiner of unobvious patentability as between the claims of respective groups in order to support the restriction requirement, and the absence of such a showing by the examiner in this restriction requirement, applicants respectfully submit that the restriction requirement in its current form is fundamentally flawed and without adequate basis.

For the foregoing reasons, applicants respectfully submit that the examiner's restriction requirement is erroneous, does not meet the controlling criteria for a finding of distinctness and should be withdrawn.

The examiner has further based the distinctness position on an assertion that the inventions defined by the segregated groups of claims are distinct because they purportedly "have acquired a separate status in the art as shown by their different classification...". Applicants respectfully submit that this bald conclusion does not support a finding of distinctness. Classification in the sense

used by the examiner relates to where the patents, which might issue containing such claims, would be classified. Asserting that the issuing patents would be differently classified presumes that the claims of the prospective patents would be patentably distinct one from another. However, as demonstrated above, there has been no showing by the examiner of patentable unobviousness among or between the groups of claims. Without a showing of patentable unobviousness among or between the groups of claims, the assertion that the claims in the groups, were they to issue in different patents, would be in different classes is unsupported speculation.

### **The Required Scope Of The Search**

The most salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicants are entitled to a full and thorough search of the prior art as a consequence of having filed their application and having paid the statutory application fee:

The director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the director shall issue a patent therefor. 35 U.S.C. 131

Restriction is proper only where an examiner would be unduly burdened by searching numerous, **unrelated** inventions or technologies. The scope of a search for related inventions, even though possibly burdensome, cannot by itself justify restriction of related inventions. If an application includes claims to related inventions that happen to be "distinct" (as such term as used in restriction

practice) inventions, the examiner **must** examine the application on its merits, in its entirety, if the search and examination of the entire patent application can be made without a serious burden on the examiner:

If the search and examination of **an entire application** can be made without serious burden, the examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions**. MPEP 803.

In developing a search strategy and mapping the scope of a search, claims are to be given their broadest reasonable interpretation, both literally and by equivalents:

All subject matter that is the equivalent of the subject matter as defined in the claim, even through specifically different from the definition in the claim, must be considered unless expressly excluded by the claimed subject matter. MPEP 904.01(b)

The examiner will not be unduly burdened by searching and examining all of the claims, as currently presented by applicants, in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since applicants have clearly manifested their intent to claim each novel and nonobvious aspect of the disclosed subject matter as evidenced by the claims in the application.

As respects to claims pending in the application and applicant's provisional election of the claims of Group 2 for immediate prosecution, the examiner's search respecting those claims, in order to be thorough will necessarily need to search with respect to the subject matter of the claims of Group 1 as well. Since fourteen of the claims of Group 2 are dependent on and hence incorporate structural limitations, material limitations, or both from claims



of Group 1, the yarn and fiber subject matter of the claims of Group 1 will necessarily have to be searched by the examiner in the course of the examiner's determination as to whether the claims of Group 2, being directed to fabric (claims 12, 14 and 15), a carded batt (claim 13), other yarns and fibers (claims 20 and 21), a needlefelt (claims 29 and 30) derived from fibers defined by claims in Group 1, and a scrim support needlefelt (claims 48 through 51) made from a blend of fibers defined by claims in Group 1, are patentable.

The examiner's instructional guidelines for performing a search for any application are set forth in the MPEP. The guidelines require the examiner to search in classes and subclasses in which arguably distinct (as defined by the MPEP) inventions would be classified:

"Not only must the art be searched with which the invention claimed is classifiable, but **also all analogous arts regardless of where classified.**

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. MPEP 904.01(c) (emphasis added).

A proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified. MPEP 904.02(a), ¶1.

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, **that may have material pertinent to the subject matter as claimed.** Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.** MPEP 904.02(a), ¶2 (emphasis added).

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, **commensurate with the limitations appearing in the most detailed claims** in the case, be made in preparing the first action ... It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; **but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.** MPEP 904.03, ¶ 1 (emphasis added)

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious. MPEP 904.03 ¶ 2

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure... MPEP 904.03 ¶ 3.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) Classes and subclasses in which the claimed subject matter is classified;
- (2) Classes and subclasses that may have material pertinent to the claimed subject matter;
- (3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and
- (4) Classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed.

Given this mandate, Applicants submit that all of the classes defined by the examiner as those in which the claims of this application arguably reside, must be searched no matter which group of claims Applicants have elected for

immediate prosecution.<sup>3</sup> Accordingly, from the guidance provided by the Manual of Patent Examining Procedure, it is clear that the examiner, even if the restriction requirements stands, will need to search the classes and subclasses in which the claims of Group 2, which have been provisionally elected by the applicants, reside. Additionally, the examiner will need to search other classes and subclasses which may have material pertinent to the claimed subject matter. These classes and subclasses would surely include the classes and subclasses for the claims of Group 1 directed to the yarns and fibers, which are limitations appearing in the claims of Group 2 as demonstrated above.

The examiner will further need to search classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to claimed during the prosecution; this includes fabrics and methods for use of fabrics as well as the subject matter of the claims of Group 3. Additionally, the examiner will need to search classes and subclasses relating to methods for manufacture of yarns, fibers, fabrics and the other subject matter disclosed in the instant application since references relating to methods of manufacture may be relevant to the patentability of the fabrics to which the claims of Group 2, the provisionally elected group, are directed.

All of this being the case, it should be clear that the examiner's search for the elected group of claims will necessarily be of sufficient breath to serve as adequate search for the non-elected groups of claims, namely the claims of Group 1 and 3. It surely makes no sense for applicants to be required to file

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<sup>3</sup> See paragraphs 11, 12, 14 and 15 of the attached Declaration of Frank Cistone.

divisional applications to secure a search of the claims of Groups 1 and 3 when such searches will necessarily be performed in the course of prosecution of the instant application. Conservation of resources, both time and financial, mandates that, given the required scope of the search for the claims of Group 2 as elected by the applicants, no further searching be performed and the claims of Group 1 and 3 also be considered and prosecuted in the instant application. No other approach makes sense.

**The Proposed Restriction Would Be Unduly Economically Burdensome On Applicant**

The restriction requirement places a devastating economic load on the applicants, which will severely adversely impact the applicants' ability to compete in the marketplace and may threaten the economic viability of the enterprise to which this application is assigned.<sup>4</sup> While the Patent and Trademark Office has a legitimate interest in obtaining proper revenue from filing, issuance and maintenance fees, it does not have unrestrained power to tax inventors or the entrepreneurial enterprises employing them. Applicants are entitled to obtain patent protection on each of the nonobvious inventive aspects of the subject matter which applicants have disclosed. If applicants are forced to divide this application into three separate patent applications as suggested by the examiner, or even four applications if claims 35-38, which are not currently subject to restriction, are considered to be a fourth group, this will be unduly and unfairly burdensome to the applicants, due to the extra fees and costs associated with

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<sup>4</sup> See paragraphs 7, 8 of the attached Declaration of Frank Cistone.

prosecuting two or three additional patent applications and maintaining two or three additional patents.

Table 1 sets forth the divisional application filing costs which would be incurred by the applicants in the event the restriction requirement stands and two or three divisional applications are required:

**TABLE 1: DIVISIONAL APPLICATION FILING COST**

<b>Group Number</b>	<b>I</b>	<b>II</b>	<b>III</b>	<b>IV</b>
Independent Claims	5	9	3	4
Excess Independent Claims	2	7	0	1
Excess Independent Claim Fee	\$86.00	\$0	\$0	\$43.00
Total Claims	11	22	3	4
Excess Claims	0	2	0	0
Excess Claims Fee	\$0	\$18.00	\$0	\$0
<b>Multiple Dependent Claim Fee</b>				
Basic Filing Fee	\$385.00	\$385.00	\$385.00	\$385.00
Total Filing Fee	<u>\$471.00</u>	<u>\$548.00</u>	<u>\$385.00</u>	<u>\$428.00</u>

Total of Filing and Claims Fees Already Paid by Applicant \$1,488.00

As can be seen from Table 1, applicants will be forced to pay additional filing fees up to \$1,284.00 to file three divisional applications in the event the restriction requirement is not withdrawn.

As further indicated on Table 1, applicants have already paid \$1,488.00 in filing and claims fees to date. If applicants are forced to adhere the restriction requirement and continue with the prosecution of the claims of Group 2 in the instant application, \$940.00 of this will be forfeited since a number of claims will

not be examined in the instant application despite the fact that applicant has paid the fees therefor. Indeed, applicants will be forced to pay \$1,284.00 additional to secure examination of independent and defendant claims *for which applicants have already paid*. Hence, applicants will incur an initial, non-recoverable penalty of \$1,284.00 in official fees alone in the event applicants are required to adhere to the outstanding restriction requirement and file divisional applications for the three non-elected groups of claims.

Applicants further note that the figures given in Table 1 do not include attorney fees, associated costs and expenses. The attorney fees associated with filing each such divisional patent application will probably be around \$1,000.00; this figure is taken by analogy from the figure appearing in the AIPLA Report of Economics Survey 2003 for the filing of a patent application as a PCT application in the United States as the receiving office where the patent application filed was based on either a previously prepared U.S. patent application as the PCT application or was a foreign origin PCT application.

Furthermore, applicants will be faced with preparing amendments and arguments for any such divisional applications in response to official action to be issued by the United States Patent and Trademark Office. Again based on the AIPLA Report of Economic Survey 2003, from figures given for the costs to prepare an amendment and argument of minimal complexity, it can be expected that the applicant will face fees of in the neighborhood of \$2,200.00 for each amendment and argument which may be required in response to an official action. Additionally, there will be attorney fees associated with the payment of

any issue fee if allowed claims are obtained; this will amount to about \$700.00 per application, again based on the AIPLA Report of Economic Survey 2003. Add to this fees for the preparation and filing of information disclosure statements, and the ordinary and routine reporting letters to the client, the result is that the attorney fees associated with the filing and prosecution of two (2) or three (3) divisional applications could easily amount to \$7,000.00 or \$8,000.00 per application, leading to a further incremental cost to the applicants of from \$14,000.00 to \$24,000.00 if the restriction requirements stands.

Applicants further submit that the restriction requirement will be further burdensome on applicants since it is expected that off-shore patent offices will likely follow any lead of the United States Patent and Trademark Office in requiring "unity of invention" restriction of the counterpart pending foreign applications. It is quite common for foreign patent offices to inquire as to the action(s) taken by the United States Patent and Trademark Office in connection with the counterpart U.S. application, especially where the inventors are citizens of the United States and the U.S. application is timewise ahead of the foreign applications in prosecution activity. Applicants have filed counterpart foreign applications in the European Patent Office, Japan, Mexico and Canada. If the European Patent Office, the Canadian Patent Office the Mexican Patent Office and the Japanese Patent Office consider the action of the U.S. patent examiner to establish a restriction precedent for the counterpart European, Canadian, Mexican and Japanese patent applications, applicant will be further economically penalized by being forced to pay additional filing, prosecution, agent, issue and

maintenance fees in Europe, Canada, Mexico and Japan for counterpart patent protection. This is another reason mandating reconsideration and withdrawal of the restriction requirement.

Table 2 presents the patent issue fees and maintenance costs applicants will face in the event the restriction requirement stands and applicants are successful in prosecuting the parent application and three divisional applications to allowance:

**TABLE 2: PATENT MAINTENANCE COST**

<b>Number of Patents</b>	<b>1</b>	<b>2</b>	<b>3</b>	<b>4</b>
Issue and Publication Fees	965.00	1,930.00	2,895.00	3,860.00
1 <sup>st</sup> Maintenance Fee	455.00	910.00	1,365.00	1,820.00
2 <sup>nd</sup> Maintenance Fee	1,045.00	2,090.00	3,135.00	4,180.00
3 <sup>rd</sup> Maintenance Fee	<u>1,610.00</u>	<u>3,220.00</u>	<u>4,830.00</u>	<u>6,440.00</u>
<b>TOTAL</b>	<b>\$4,075.00</b>	<b>\$8,150.00</b>	<b>\$12,225.00</b>	<b>\$16,300.00</b>

Even from Table 2, which presents the maintenance fee costs at today's February 2004 levels, it is apparent that applicants will face United States Patent and Trademark Office issue and maintenance fees amounting to \$12,225.00 extra, over and above the cost to issue and maintain a single patent directed to the invention, if the restriction requirement stands. When this figure is combined with the figures discussed above, the total financial penalty applicants potentially



face in domestic official fees alone could easily be \$36,000.00, just as a result of the restriction requirement.

Further respecting the foreign situation, if the restriction requirement stands and the foreign patent offices follow the lead of the United States Patent and Trademark Office, applicants will be faced with paying maintenance fees on foreign patents, presuming such patents issue, in an amount at least triple what applicants would otherwise be facing since three applications or possibly even four applications and three or four issued patents will need to be maintained on the basis of the current restriction requirement if applied by the offshore patent and trademark offices. This could easily amount to an additional \$50,000.00 over the lives of the foreign patents which will presumably issue. Applicants respectfully submit that applicants should not be burdened in this manner and that the restriction requirement should be reconsidered and withdrawn in its entirety.

**The Patent Office's Responsibility Is Public Service,  
Not Revenue Generation**

While applicants recognize the Patent and Trademark Office interest in obtaining proper revenue from filing and issuance fees, the Patent and Trademark Office is not in the business of assisting the IRS in financing the war on terrorism or reducing the national debt. The sole function of the Patent and Trademark Office is to serve inventors and the public in an efficient and expeditious manner. The Patent and Trademark Office is charged with a duty to carry out its responsibility of examining patent applications thoroughly and

efficiently. Efficient use of administrative resources and expeditious processing of this application will be better served by performing one comprehensive search, as contrasted to multiple largely, if not completely, overlapping searches of the classes defined by the examiner in levying the erroneously-based restriction requirement.


### Conclusion

For all of the foregoing reasons, applicants respectfully submit that the restriction requirement set forth in the paper dated 2 October 2003 is not well founded and should be withdrawn. Applicants again request prompt and thorough examination of all of the claims pending in the application.

In the event there is any fee required in connection with this submission, please charge the same to applicants' undersigned counsel's Deposit Account No. 50-1943.

Respectfully submitted,

Date: 2 February 2004

  
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Michi Lockner  
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BY: Michi Lockner

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